



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,436	08/13/2001	Mitra Tadayoni-Rebek	0942.5300001/RWE/AGU	6227
26111	7590	07/20/2004	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			LUKTON, DAVID	
			ART UNIT	PAPER NUMBER
			1653	

DATE MAILED: 07/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

MS

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
---------------	-------------	-----------------------	---------------------

09/927436

[

]

EXAMINER

ART UNIT	PAPER NUMBER
----------	--------------

2004/0701

L

]

DATE MAILED:

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Please see the attached communication regarding applicants' response to the restriction requirement (mailed 1/28/04).

Pursuant to preliminary amendment (filed 6/28/04), claims 1-15 and 21-38 have been cancelled, and claims 39-48 added. Claims 16-20 and 39-48 are now pending.

The restriction requirement is rendered moot by the cancellation of claims 1-15 and 21-38. Applicants' attempt to comply with the "election of species" requirement is acknowledged. In response to selection of a specific "marker molecule" (that is the "target" of the synthesis), applicants have argued that a compound which "comprises" the peptide of SEQ ID NO: 3 would qualify. However, a "specie" does not "comprise" a given compound, a specie does not "consist essentially of" a given compound, and a specie does not consist of a specified molecule which is bonded to an unspecified entity. A specie is a fully defined molecule with all atoms in that molecule accounted for. Thus, selection of a "marker molecule" as being any compound which comprises the peptide of SEQ ID NO: 3 is regarded as non-responsive.

In response to the requirement to select a protein (of step (b), claim 16), applicants have chosen "MBP-95aa". However, this too is regarded as non-responsive. As is evident from a reading of page 35 (specification), "MBP-95aa" does not contain a thioester group, which is required by claim 16. What may be intended is for the C-terminal carboxyl group of the "MBP-95aa" to be in thioester linkage with *beta*-thioethanesulfonic acid (SH-CH₂-CH₂-SO₃H). If this is the intention, it can be so indicated. If some other *alpha*-

thioester- containing protein is intended instead, the position of thioester group in the protein should be made clear.

Applicants have also chosen tetramethylrhodamine as the compound to be used for “labeling a molecule”. However, tetramethylrhodamine itself will not react with the peptide of SEQ ID NO: 3 (or with any other peptide that consists entirely of genetically-encoded amino acids). In order to achieve reaction between TMR and a nucleophilic group on a given molecule, some sort of reactive group must be present. The most commonly used such group is the isothiocyanate group. This may have been used. In any case, tetramethylrhodamine *per se* could not have been used. Identification of a specific molecule that was reacted with the peptide of SEQ ID NO: 3 (or other peptide of applicants’ choice) is required.

Thus, the foregoing elections are non-responsive to the “election of species” requirement. Election of the previously identified species is still required. The time period for response (one month) is reset pursuant to this Office action. However, failure to elect species in compliance with the “election of species” requirement will result in abandonment of the application.



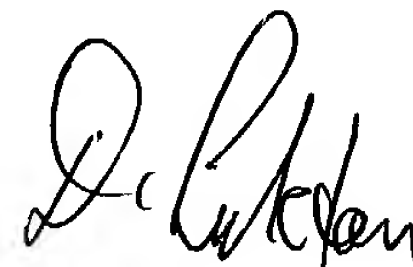
Serial No. 09/927,436
Art Unit 1653

-4-

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jon Weber, can be reached at 571-272-0925. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.



**DAVID LUKTON
PATENT EXAMINER
GROUP 1800**